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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/714,987 09/17/96 SHARKEY

H 17616-705

EXAMINER

QM12/0212

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SHAY, D.

ART UNIT

PAPER NUMBER

3739

DATE MAILED:

02/12/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**



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DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on September 5, 2000 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s),        days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.                 | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____  |

Part II SUMMARY OF ACTION

1. ☒ Claims 45-73 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☒ Claims 1-44 have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims 45-73 are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

PTOL-320

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The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 30-58 been renumbered 45-73.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 45-47 51, 52, 56, and 59-73 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Makower.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 53-55, 57, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makower in combination with Makower et al..

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Makower et al teaches a device such as claimed wherein the energy applicator is an optical fiber. Makower et al teach the equivalence of thermistors, thermocouples, and fiber sensors and of microwave, R.F, resistive and laser applicators for heating. It would have been obvious to the artisan of ordinary skill to employ the temperature sensors and heating sources of Makower et al in the device of Makower, since these are equivalents in the art, as taught by Makower et al, thus producing a device<sup>e</sup> such as claimed. dr

Claims 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makower in combination with Makower et al as applied to claim 53-55, 57, and 58 above, and further in view of Swanson et al. Swanson et al teaches configuring energy emitters of platinum<sup>n</sup>, stainless dr steel, and shape memory material. It would have been obvious to the artisan of ordinary skill to form the RF emitter as taught by Swanson et al, thus producing a device such as claimed.

Applicants arguments have been fully considered, but are drawn to the method of use, rather than the claimed structure. It is noted that there is nothing in the structure of the device of Makower which would prevent it from being used without penetrating the surface of the selected site. Regarding the claimed sensor location, attention is respectfully invited to figure 11 and the description thereof in the last two paragraphs of page 10 regarding the operation associated with needle 15', the needle is left in place during energy emission here the sensors are clearly interior to the energy delivering device comprising needle 15' and fiber optic 23'. It is also respectfully noted that even with regard to fiber optic 23" <sup>a</sup>the thermocouples are described dr


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as "mounted in cladding 38"<sup>^</sup> emphasis added) and are thus considered interior to the energy emitter. *d*

Applicant's arguments with respect to claims 45-73 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw  
January 24, 2001

  
DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330